NO. 80-1194

IN THE

Supreme Court of the United States

OCTOBER TERM, 1980

WEIDMAN METAL MASTERS CO., INC.,
Petitioner,

v.

GLASS MASTER CORPORATION
and FRED F. WILLSON,
Respondents.

On Writ Of Certiorari To The United States Court Of Appeals For The Fifth Circuit

BRIEF FOR RESPONDENTS

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BRIEF FOR RESPONDENTS

RESTATEMENT OF QUESTION ONE PRESENTED

When a district court limits the claims to exactly the structure illustrated in a patent and holds the patent non-infringed and a Court of Appeals disagrees and construes the patent to teach an invention broader than the struc-

ture illustrated, is it proper for the Court of Appeals to determine that the broader construed patent claims are infringed by the accused structure?

ADDITIONAL STATEMENT OF THE CASE

The Court of Appeals interpreted the district court to limit the patent

> ". . . to a device with a resilient blade positioned directly over the roller." Weidman Metal Masters Co., Inc. v. Glass Master Corp. (CA5 1980) 623 F.2d 1024, 1028).

The Court of Appeals disagreed with this construction of the patent and held:

> "As we construe the patent, its crucial teaching was the relationship between the support roller and the knife blade achieved when the roller transfers force through the duct board to a knife resilient enough to react to that force. Neither the position of the knife in relation to the roller nor the source of the resiliency is crucial, although both are important, as evidenced by the inferior performance of the Weidman Machine. However, in regarding these factors as limitations on the patent and finding no infringement for that reason, the district judge erred." (supra 1030)

REASONS FOR DENYING THE WRIT

1. The Construction of a Patent is a Question of Law for the Court

The construction of a patent as a question of law was established at least as early as 1883 in *Winans v. Denmead,* 15 Howard 330, 14 L.Ed. 717 where the court stated:

> "On such a trial, two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used or sold by the defendants.
>
> The first is a question of law, to be determined by the court, construing the letters patent, and the description of the invention and specification of claims annexed to them. The second is a question of fact, to be submitted to a jury."

This principle has been followed without question for over 100 years. *Bates v. Coe*, 98 U.S. 31, 25 L.Ed. 68; *Coupe v. Royer*, 155 U.S. 565, 39 L.Ed. 263, 15 S.Ct. 199; *U.S. v. Adams*, 383 U.S. 39, 15 L.Ed.2d 572, 86 S.Ct. 708; *Gottschalk v. Benson*, 409 U.S. 63, 34 L.Ed. 2d 273, 93 S.Ct. 253.

2. Findings of Fact Based Upon Erroneous Legal Findings May Be Corrected on Appeal

In considering the trial court's findings of fact, the Supreme Court stated in a footnote to *United States v. Singer Mfg. Co.*, 374 U.S. 174, 195, 10 L.Ed.2d 823, 838, 82 S.Ct. 1773:

> "Insofar as that conclusion derived from the court's application of an improper standard to the facts, it may be corrected as a matter of law."

To the same effect are *United States v. General Motors Corp.*, 384 U.S. 127, 16 L.Ed.2d 415, 86 S.Ct. 1321; and *United States v. Parke Davis & Co.*, 362 U.S. 29, 4 L.Ed.2d 505, 80 S.Ct. 503.

3. The Supreme Court Has Consistently Held That Where the Appellate Court Construes a Patent Broader Than the Court Below, the Appellate Court Should Determine the Issue of Infringement of the Broader Construed Claims

In *Smith v. Snow*, 294 U.S. 1, 79 L.Ed. 721, 55 S.Ct. 279, the court below limited the construction of the patent to a particular arrangement of eggs and air flow in an incubator and held the patent not infringed. The Supreme Court construed the patent broadly and held the court below erred in so limiting the patent. The court then proceeded to apply the broadly construed claims to the accused structure and held it infringed.

This procedure has been consistently followed. *Brown v. Guild (The Corn-Planter Patent)*, 23 Wall 181, 23 L.Ed. 160; *The National Cash Register Co. v. Boston Cash Indicator & Recorder Co.*, 156 U.S. 502, 39 L.Ed. 511, 15 S.Ct. 434; *Consolidated Safety Valve Company v. Crosby Steam Gauge and Valve Co.*, 113 U.S. 157, 28 L.Ed. 939, 5 S.Ct. 513; *Morley Sewing Machine Co. v. Lancaster*, 129 U.S. 263, 32 L.Ed. 715, 9 S.Ct. 299; *Seymour v. Osborne*, 11 Wall 516, 20 L.Ed. 33; *Clough v. Gilbert & Barker Mfg. Co.*, 106 U.S. 166, 27 L.Ed. 134, 1 S.Ct. 188.

RESPONDENTS' REPLY TO PETITIONER'S REASONS FOR GRANTING THE WRIT

1. The Decision Below Does Not Directly and Irreconcilably Conflict With Decesions of This Court on the Determination of Equivalence and the Standard of Review for that Determination

In *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605, 94 L.Ed. 1097, 70 S.Ct. 854,

the Courts below had both held the claims in issue to be infringed. *There was no disagreement between the Supreme Court and the lower Court as to the scope of the invention.* In the instant case the Court of Appeals reversed the District Court's ultimate holding of non-infringement, *because it construed the patent differently than the District Court.* Thus, the issues are completely different and there is no conflict between the decisions.

Having held the claims to be broad enough to include the infringing structure nothing would be gained by remanding the case for a determination by the District Court of the same issues decided by the Court of Appeals. The Court of Appeals correctly determined that the claims were infringed. *Smith v. Snow, supra.*

2. The Decision Below Does Not Directly and Irreconcilably Conflict With Decisions of This Court on the Necessity for Basic Factual Inquiries Prior to Resolving Obviousness

Petitioner relies upon *Graham v. John Deere Co.*, 383 U.S. 1, 15 L.Ed.2d 545, 86 S.Ct. 684. The *Graham* Court did not remand the case for findings by the trial court. It defined the invention and decided the issue of validity based upon the record before it.

As in *Graham*, the Court below in this case defined the invention, it considered the prior art as presented by Petitioners, it determined the difference between the prior art and the claims and ruled the invention not obvious to a man skilled in the art.

There is no requirement in *Graham* that an Appeals Court remand a case for additional findings of validity. The Appeals Court in the instant case followed exactly

the procedure of the *Graham* Court and there is no conflict in the two decisions.

To follow Petitioner's suggested procedure would result in a case traveling between the Trial and Appellate Courts several times before final judgment, as each instance of disagreement on one issue would require a remand for consideration of all related issues.

3. The Decision Below Does Not Conflict With the Decisions of Other Courts of Appeals On Equivalence and the Standard of Review of a Trial Court's Determination as to Infringement and Equivalence

4. The Decision Below Does Not Conflict With Other Fifth Circuit Cases on Equivalence and the Standard of Review of a Trial Court's Determination as to Infringement and Equivalence

5. The Decision Below Does Not Raise Significant and Recurring Problems Concerning the Appropriate Standard of Review of Determinations as to Infringement and Equivalence

The cases cited under these three propositions are not in conflict. In those cases in which tne Court of Appeals agreed with the lower Court in its construction of claims it affirmed the lower Court's holding as to infringement. Where the Court disagreed as to claim construction it reversed the District Court holding as to infringement. (See Appendix A for grouping of cases according to decisions.)

Ziegler v. Phillips Petroleum Co., 483 F.2d 858 (CA 5 1973) *cert. denied*, 414 U.S. 1079 illustrates the issue.

Two patents were involved. As to one patent the Appeals Court agreed with the trial Court's construction of the claims and affirmed its holding on infringement. As to the other patent the Court of Appeals disagreed with the trial Court's construction of the patent and reversed as to the issue of infringement.

An examination of each of the cases cited by Petitioner will reflect that only where the Court of Appeals disagreed with the District Court's construction of the patent did it reverse on the issue of infringement.

The cases cited by Petitioner follow the companion cases of *Smith v. Snow, supra,* and *Waxham v. Smith,* 294 U.S. 20, 79 L.Ed. 733, 55 S.Ct. 277 involving the same patent. In the *Snow* case the Court construed the patent broader than the Court below and reversed as to infringement. In the *Waxham* case the Court agreed with the decisions of the two Courts below that the invention was broad enough to cover the petitioner's structure and noting that the evidence supported the findings below affirmed the holding of infringement.

Petitioner urges that *Kemart Corp. v. Printing Arts Research Laboratories, Inc.* (CA9, 1953), 201 F.2d 624 and other cases erred in holding that undisputed facts and clearly comprehendable structures render the question of infringement a question of law. *Kemart* cites and follows the teaching of *United States v. Esnault-Pelterie,* 303 U.S. 26, 82 L.Ed. 625, 58 S.Ct. 412 where the Court said:

> "We are not unmindful of the rule that where, with all the evidence before the court, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for

purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject-matter, the questions of invention and infringement may be determined as questions of law." *Heald v. Rice,* 104 U.S. 737, 749, 26 L.Ed. 910, 914; *Singer Mfg. Co. v. Cramer,* 192 U.S. 265, 275, 48 L.Ed. 437, 443, 24 S.Ct. 291; *Sanitary Refrigerator Co. v. Winters,* 280 U.S. 30, 36, 74 L.Ed. 147, 153, 50 S.Ct. 9.

CONCLUSION

The Supreme Court has given ample guidelines as to the issues of fact and law in patent cases. The Court below, including the Fifth Circuit Court of Appeals in this case, are in harmony in their treatment of the issues of patent construction and infringement and are following such guidelines. The Writ should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned, attorney for Respondents, Glass Master Corporation and Fred F. Willson, hereby certifies that the foregoing Brief for Respondents, was served on Petitioner (the only party required to be served) this _____day of February, 1981, by placing a copy of it in the United States mail, first-class postage prepaid, addressed to Petitioner's attorney, Rodney K. Caldwell, c/o Arnold, White & Durkee, 2100 Transco Tower, Houston, Texas 77056.

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APPENDIX A

CASES CITED BY PETITIONER UNDER REASONS 3, 4 AND 5 GROUPED ACCORDING TO DECISION

1. Cases Disagreeing With the Trial Court's Construction of the Patent and Reversing the Holding as to Infringement

Olympic Fastening Systems, Inc. v. Textron Inc. (CA6 1974) 504 F.2d 609, *cert. denied,* 420 U.S. 1004 (1975).

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Ziegler v. Phillips Petroleum Co. (CA5 1973) 483 F.2d 858, *cert. denied,* 414 U.S. 1079 (1973) (as to Patent No. 3,113,115).

U.S. Industries, Inc. v. Otis Engineering Corp. (CA5 1960) 277 F.2d 282, *cert. denied,* 414 U.S. 1079 (1973).

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Del Francia v. Stanthony Corp. (CA9 1960) 278 F.2d 745.

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